

### REMARKS

The present application was filed on January 25, 2001 with claims 1-19. Claims 1-6 and 8-19 are currently pending in the application. Claims 1 and 17-19 are the independent claims.

In the Office Action, claims 1-5, 8-12, 15 and 17-19 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,568,541 to Greene (hereinafter "Greene"). In addition, claim 6 is rejected under U.S.C. §103(a) as being unpatentable over Greene in view of U.S. Patent No. 6,595,424 to Harrison (hereinafter "Harrison"). Finally, claims 7 and 13-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greene in view of Harrison in further view of U.S. Patent No. 5,148,474 to Haralambopoulos et al. (hereinafter "Haralambopoulos").

The Examiner indicates that claim 16 would be allowable if rewritten in independent form.

Applicant initially notes that the Examiner states in the Office Action on p. 2 that "[t]his is a response to a letter for a patent filed May 15, 2001 in which claims 1-15 are pending." This is incorrect. The present application was filed on January 25, 2001. Claims 1-19 were pending at the time the Examiner wrote the Office Action.

It is further noted that, in the §103(a) rejection of claims 7 and 13-14 on p. 6 of the Office Action, the Examiner states that the claims are unpatentable "over Greene in view of Harrison in further view of Haralambopoulos." Applicant notes, however, that the subsequent text fails to mention the role of the Harrison reference in the rejection of these claims. Applicant therefore proceeds in this response under the assumption that the §103(a) rejection of claims 7 and 13-14 is based on Greene in view of Haralambopoulos, without Harrison.

In this response, Applicant chooses to amend independent claims 1 and 17-19 to incorporate the limitations of dependent claim 7. Claim 7 is, as a consequence, canceled. In addition, dependent claims 13 and 14 are amended to better depend on claim 1, as amended. Since the Examiner states that claim 16 contains allowable subject matter, it is rewritten in independent form with the limitations of the original claim 1.

With respect to this §103(a) rejection, Applicant initially notes that the Manual of Patent Examining Procedure, Eighth Edition, August 2001 (MPEP) §2143.03 states that in order "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art," citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The independent claims, as amended by the limitations of claim 7, each include “user - specified access cost information including one or more access rules specified by the user and indicating a particular access cost for an incoming call under one or more specified conditions.” In formulating the §103(a) rejection of claim 7, the Examiner states:

In claims 7 and 13-14, Greene does not disclose that the user specified access control information comprises a caller-specific access cost, a caller-specific access rule, general access cost, or a general access rule. Haralambopoulos et al. disclose that the service provider (called party) has a plurality of individual value-added telephone numbers with each representing a different billing rate to reflect the services rendered (col. 5, lines 48-52). Haralambopoulos et al. further disclose that in addition to time related billing rates, the service provider (called party) may have numbers which enable a single item charge. (Office Action, p. 6).

Applicant respectfully asserts that the “plurality of value-added telephone numbers” of Haralambopoulos fails to meet the limitations of claim 7. Haralambopoulos describes a system wherein the charges incurred by the caller are determined after the caller dials the called party (Haralambopoulos, col. 5, lines 32-35). More specifically, if during the course of a conversation it is determined that the caller is to be charged, the caller is asked to dial a “value-added exchange number” which establishes a billing rate for the remainder of the call (Haralambopoulos, col. 5, lines 35-48). As a result, Haralambopoulos describes a system which depends on an action by the called party (i.e., asking the caller to dial a “value-added exchange number”) and an action by the caller (i.e., dialing the exchange number) in order to establish a billing rate for a call. Claim 7, on the other hand, describes a system in which any access costs incurred by the caller are dependent on “one or more specified conditions” associated with an incoming call. These conditions for example, may include the caller identifier of a given incoming call, the time of the incoming call, and from which area code the incoming call originates (Specification, p. 7, line 24 through p. 8, line 6). Because these conditions are intrinsic to an incoming call, the present invention has the advantage that no actions by the called party or caller during a conversation are required to establish a billing rate. The

Greene and Haralambopoulos combination, therefore, fails to teach or suggest every limitation of claim 7, as required for a valid obviousness rejection under §103(a).

In addition, Greene and Haralambopoulos provide entirely distinct approaches to creating a system for setting up billing rates for incoming calls. MPEP §2143.01 states that, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious, citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the embodiment of Greene relied on by the Examiner in formulating the §103(a) rejection of claim 7, Greene describes a automated approach to assigning a billing rate to an incoming call involving identifying the number of the calling party (Greene, col. 3, lines 39-44). Haralambopoulos, in contrast, describes a system that depends on user actions during a conversation to assign a billing rate (Haralambopoulos, col. 5, lines 32-48). Therefore, Haralambopoulos, by depending on user actions during a conversation to assign a billing rate instead of an automated process, changes the principle of operation of the system described by Greene. These prior art references cannot, as a result, be combined to create a *prima facie* obviousness rejection.

Moreover, in formulating the §103(a) rejection of claim 7, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Green (*sic*) to include the system of Haralambopoulos et al. in order to store the caller-specified costs and rules in database associated with the user terminal to provide the user the convenience to modify or change charges and rules.

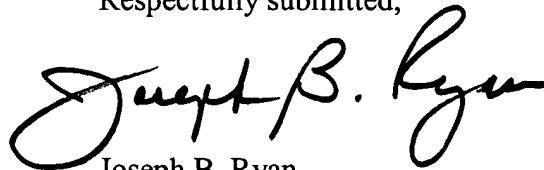
(Office Action, p. 6-7).

The Federal Circuit has stated that when patentability turns on the questions of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual questions of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

Applicant respectfully submits that there has been no such showing in the present §103(a) rejection of such objective evidence of record that would motivate one skilled in the art to modify or combine the proposed reference combination. Instead the above quoted language is precisely the type of subjective, conclusory statements that the Federal Circuit has indicated provides insufficient support for an obviousness rejection.

In view of the above, Applicant believes that independent claims 1 and 17-19, as amended, are in condition for allowance. Dependent claims 2-6 and 8-16 are also believed allowable for at least the reasons stated with respect to their independent claims. Applicant, therefore, respectfully requests withdrawal of the §102(b) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" being clearly legible.

Date: March 16, 2005

Joseph B. Ryan  
Attorney for Applicant(s)  
Reg. No. 37,922  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560  
(516) 759-7517